

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CAL YUDIN

Appeal No. 96-3064
Application 08/089,512¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and PATE
and McQUADE, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 7-
13. These are the only claims remaining in the application.

The claimed invention is directed to a method for

¹ Application for patent filed July 21, 1993.

displaying and simulating the use of transparent liquid windshield treatment. The treatment is marketed in a clear bottle with labels affixed to the front and back thereof. The exterior-facing portion of front label has a cut-out portion through which the interior-facing side of the rear label can be seen through the bottle. To generate the simulation, the potential customer shakes the bottle, whereby bubbles form on the interior surface of the bottle wall and rise to the top of the bottle. The rising bubbles simulate beads of water climbing up the automobile windshield.

Claim 11 reproduced below is further illustrative of the claimed subject matter.

11. A method of simulating the beading and sheeting action on a windshield of a liquid windshield treatment product, said method comprising the steps of placing the product in a substantially clear bottle having interior surfaces, applying a front label to the bottle with the front label being formed with a cut-out portion revealing product within the bottle, applying a back label to the bottle in a location to be viewed through the cut-out portion of the front label with the back label having a graphic indicia printed thereon, shaking the bottle to cause small bubbles to form in the liquid product and migrate to the interior surfaces of the bottle, and placing the shaken bottle in an upright orientation to cause the bubbles to rise up the interior surfaces of the bottle and past the cut-out portion formed in the front label thereby simulating through the cut-out portion the beading and sheeting action of the product when applied to an actual windshield.

The reference of record relied upon by the examiner as evidence of obviousness is:

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Marks

4,115,939

Sept. 26, 1978

The appellant has stated in the brief that the claims do not stand or fall together and has provided reasons, therefore, in the argument section of his brief.

The examiner has rejected claims 7-13 under 35 U.S.C. § 103 as unpatentable over Marks.

The examiner states the rejection, thusly:

"Marks does not disclose the method step of shaking the bottle in order to form small bubbles in the bottle. Marks does show in figures 1-5 a plastic bottle (10) comprising a front label (12) having a cut-out portion (16), a back label (14) having graphic indicia (36) printed thereon, and a transparent or translucent liquid product (see column 3, lines 17-20). Marks discloses in column 3, lines 17-20 that the liquid product could be an alcoholic beverage or some other kind of transparent or translucent product. It is considered to be within one skilled [sic, the level of skill] in the art to place a windshield treatment in the bottle since this type of product is known to be transparent or translucent. Further, in regard to the step of shaking the bottle, a person picking the bottle up and setting it back down is considered to be equivalent to the shaking step. Also, products such as windshield treatments generally have directions which suggest that the bottle be shaken before it is used. It would have been obvious to one in the art to modify Marks by shaking the bottle since this would occur during normal use of the

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bottle and because products such as windshield treatments must be shook [sic] before it can be properly used. In regard to claims 9, 10, 12, and 13, Marks does not disclose making the graphics on the front and rear labels in the form of a car windshield on the front label and an oncoming vehicle on the rear label. It would have been obvious to one in the art to modify Marks by replacing the graphics on the front and rear labels with that taught by the applicant since the type of indicia displayed can be modified to form any desired display."
[Final Rejection at 2-3]

OPINION

We have carefully reviewed the rejection on appeal in light of the arguments of the examiner and the appellant. As a result of this review, we have determined that the examiner has not established a prima facie case of obviousness with respect to the claims on appeal. Therefore, the rejection of these claims is reversed.

As an initial matter, we must point out that all claims on appeal are method claims which are restricted to the use of displaying and simulating the functioning of a windshield treatment. Turning to the Marks disclosure, it is our finding that Marks discloses a bottle containing a liquid 15, which for example, may be an alcoholic beverage or the like. The front label in Marks has a cut-away window 16 through which a portion

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of the interior side of the rear label 30 is visible. Therefore, we are in agreement with the examiner that Marks discloses providing a bottle with a front label formed with a cut-out portion which reveals the product in the bottle and shows a portion of the back label through the product in the bottle. However, with respect to the other method claim steps in the independent claims on appeal, we find no teaching or suggestion of any of these steps in the patent to Marks. For example, there is no teaching or suggestion in Marks of placing the windshield treatment fluid in the liquor bottle of Marks. Likewise, there is no teaching or suggestion in Marks, of shaking the bottle to cause small bubbles to form in the liquor disclosed in Marks, let alone, causing small bubbles to form in the windshield treatment placed in the bottle of Marks. There is no teaching in Marks that the liquid contained in the bottle would need shaking for any reason, not to mention, the examiner's argued reason of properly mixing the product. We can only conclude that here, the examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is

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rendered obvious. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d
1780, 1784 (Fed. Cir. 1992).

The decision of the examiner is reversed.

REVERSED

HARRISON E. McCANDLISH, Senior))	
Administrative Patent Judge)	
)	
)	
)	
WILLIAM F. PATE, III)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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JOHN P. McQUADE)	
Administrative Patent Judge)	

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